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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,138	12/29/2000	Dale W. Malik	BS00-170	6782
28970	7590	04/19/2004	EXAMINER	
SHAW PITTMAN IP GROUP 1650 TYSONS BOULEVARD SUITE 1300 MCLEAN, VA 22102			PHAN, TAM T	
		ART UNIT		PAPER NUMBER
		2144		6
DATE MAILED: 04/19/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

P4

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/750,138	MALIK, DALE W.
	Examiner	Art Unit
	Tam (Jenny) Phan	2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 April 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)               |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ .  |

## **DETAILED ACTION**

1. Claims 1-29 are presented for examination.

### ***Priority***

2. No priority claims have been made.
3. The effective filing date for the subject matter defined in the pending claims in this application is 12/29/2000.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Arnold (U.S. Patent Number 6,275,848).

6. Regarding claim 1, Arnold disclosed a method for automatically managing an electronic mail server application on a host computer, said method comprising the steps of: checking an electronic mail message against a predetermined criteria; and compacting the electronic mail message if the predetermined criteria is satisfied (Abstract, Figure 2, column 2 lines 42-50, column 3 lines 39-56, column 4 lines 6-23).

7. Regarding claim 2, Arnold disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application [message switch] (Figures 1-2, column 2 lines 27-37, column 3 lines 45-50).

8. Regarding claim 3, Arnold disclosed a method wherein the step of checking is performed periodically on the host computer (column 2 lines 42-50, column 4 lines 9-19).

9. Regarding claim 4, Arnold disclosed a method wherein the electronic mail message is an inbound mail message addressed to a user served by the electronic mail server application (column 4 lines 6-24).

10. Regarding claim 5, Arnold disclosed a method wherein the electronic mail message is an outbound mail message sent from a user served by the electronic mail server application (column 4 lines 6-24).

11. Regarding claim 6, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 12-19).

12. Regarding claim 7, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size [configurable factors] (column 1 lines 45-57, column 4 lines 12-17, lines 64-67).

13. Regarding claim 8, Arnold disclosed a method wherein the predetermined criteria comprise an attachment type [configurable factors] (column 5 lines 16-18, column 4 lines 12-17).

14. Regarding claim 9, Arnold disclosed a method wherein the predetermined criteria comprise an expected compression ratio [configurable factors] (column 1 lines 45-57, column 4 lines 12-17).

15. Regarding claim 10, Arnold disclosed a method wherein the step of compacting comprises the step of compressing the electronic mail message (column 2 lines 42-50, column 3 lines 57-60).

16. Regarding claim 11, Arnold disclosed a method wherein the electronic mail message comprises a message body and an attachment, and wherein the step of compacting comprises the steps of: detaching the attachment from the electronic mail message; saving the attachment to a location on a second computer; and inserting an index in the electronic mail message in place of the attachment (column 2 lines 27-50, column 3 lines 52-56, column 4 lines 6-23).

17. Regarding claim 12, Arnold disclosed a method wherein the second computer is the host computer (column 3 lines 52-56).

18. Regarding claim 13, Arnold disclosed a method wherein the second computer is a local computer (column 3 lines 52-56).

19. Regarding claim 14, Arnold disclosed a method wherein the index is a uniform resource locator associated with the location of the attachment on the second computer (column 3 lines 57-62, column 4 lines 30-42).

20. Regarding claim 15, Arnold disclosed a method further comprising the step of compressing the attachment (column 1 lines 38-41).

21. Regarding claim 16, Arnold disclosed a method for reducing a size of an electronic mail message comprising an attachment, wherein said electronic mail message and said attachment are retrievable using an electronic mail application, said method comprising the steps of exporting the attachment to a location on a computer; deleting the attachment from the electronic mail message; and inserting an index in the electronic mail message, wherein said index indicates the location of the attachment on the computer (column 2 lines 27-50, column 3 lines 52-62, column 4 lines 6-23, lines 30-42).

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22. Regarding claim 17, Arnold disclosed a method wherein the index comprises a universal resource locator associated with the location of the attachment on the computer (Figure 4, column 3 lines 57-62, column 4 lines 30-42, column 5 lines 18-24).

23. Regarding claim 18, Arnold disclosed a method wherein the electronic mail application is run on the computer (Figure 4, column 3 lines 40-56).

24. Regarding claim 19, Arnold disclosed a method wherein the electronic mail application is run on a second computer (Figures 1 and 4, column 3 lines 40-56).

25. Regarding claim 20, Arnold disclosed a method wherein the second computer is accessible via the world-wide web (Figures 1 and 4, column 3 lines 40-62).

26. Regarding claims 21-29, the limitations of claims 21-29 are similar to the limitations of claims 1 and 4-9, and thus these claims are rejected using the same rationale.

27. Since all the limitations of the claimed invention were disclosed by Arnold, claims 1-29 are rejected.

***Claim Rejections - 35 USC § 103***

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (U.S. Patent No. 6,275,850), hereinafter referred to as Beyda, in view of Pollack (U.S. Patent Number 6,505,236).

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30. Regarding claim 1, Beyda disclosed a method for automatically managing an electronic mail server application on a host computer, said method comprising the steps of checking an electronic mail message against a predetermined criteria (Figure 3, column 2 lines 42-63).

31. Beyda taught the invention substantially as claimed. However, Beyda did not expressly teach compacting the electronic mail message if the predetermined criterion is satisfied.

32. Beyda suggested exploration of art and/or provided a reason to modify the method with the compacting the electronic message feature (Figure 3, column 1 lines 49-55).

33. Pollack disclosed a method for compacting the electronic mail message (Abstract, Figures 1-4, column 2 lines 11-25, column 4 lines 24-39).

34. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Beyda with the teachings of Pollack to include the compacting feature in order to eliminate potential bandwidth bottleneck (Pollack column 4 lines 24-29) since downloading a single email message with a large attached file may take several minutes (column 1 lines 49-55).

35. Regarding claim 2, Beyda and Pollack combined disclose a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23; Pollack, Figures 1-4, column 2 lines 9-25).

36. Regarding claim 3, Beyda and Pollack combined disclose a method wherein the step of checking is performed periodically on the host computer (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23; Pollack, Figures 1-4, column 2 lines 9-25).

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37. Regarding claim 4, Pollack disclosed a method wherein the electronic mail message is an inbound mail message addressed to a user served by the electronic mail server application (column 2 lines 11-25, column 3 lines 13-25).

38. Regarding claim 5, Pollack disclosed a method wherein the electronic mail message is an outbound mail message sent from a user served by the electronic mail server application (column 2 lines 11-25, column 3 lines 13-25).

39. Regarding claim 6, Beyda disclosed a method wherein the predetermined criteria comprise a total message size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

40. Regarding claim 7, Beyda disclosed a method wherein the predetermined criteria comprise an attachment size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

41. Regarding claim 8, Beyda disclosed a method wherein the predetermined criteria comprise an attachment type (Figure 3 sign 62, column 2 lines 51-63, column 3 lines 4-13).

42. Regarding claim 9, Beyda disclosed a method wherein the predetermined criteria comprise an expected compression ratio (Figure 3 sign 58, column 2 lines 51-63, column 6 lines 29-49).

43. Regarding claim 10, Pollack disclosed a method wherein the step of compacting comprises the step of compressing the electronic mail message (column 2 lines 11-25, column 5 lines 44-50).

44. Regarding claim 11, Pollack disclosed a method wherein the electronic mail message comprises a message body and an attachment, and wherein the step of

compacting comprises the steps of: detaching the attachment from the electronic mail message; saving the attachment to a location on a second computer; and inserting an index in the electronic mail message in place of the attachment (Abstract, Figures 1-4, column 2 lines 11-25, column 3 lines 13-25, column 5 lines 17-36).

45. Regarding claim 12, Pollack disclosed a method wherein the second computer is the host computer (column 4 lines 24-38, column 5 lines 56-67, column 7 lines 48-51).

46. Regarding claim 13, Pollack disclosed a method wherein the second computer is a local computer (column 4 lines 24-38, column 5 lines 56-67, column 7 lines 48-51).

47. Regarding claim 14, Pollack disclosed a method wherein the index is a uniform resource locator associated with the location of the attachment on the second computer (column 5 lines 17-26).

48. Regarding claim 15, Pollack disclosed a method further comprising the step of compressing the attachment (Abstract, column 2 lines 11-25, column 5 lines 44-50).

49. Regarding claim 16, Pollack disclosed a method for reducing a size of an electronic mail message comprising an attachment, wherein said electronic mail message and said attachment are retrievable using an electronic mail application, said method comprising the steps of exporting the attachment to a location on a computer; deleting the attachment from the electronic mail message; and inserting an index in the electronic mail message, wherein said index indicates the location of the attachment on the computer (Abstract, Figures 1-4, column 2 lines 11-25, column 3 lines 13-25, column 5 lines 17-36).

50. Regarding claim 17, Arnold disclosed a method wherein the index comprises a universal resource locator associated with the location of the attachment on the computer (Figure 4, column 3 lines 57-62, column 4 lines 30-42, column 5 lines 18-24).

51. Regarding claim 18, Beyda and Pollack disclosed a method wherein the electronic mail application is run on the computer (Beyda, Figures 1-2, column 3 lines 1-67, column 4 lines 9-23; Pollack Figure 4 sign 218, column 7 lines 36-50).

52. Regarding claim 19, Beyda and Pollack disclosed a method wherein the electronic mail application is run on a second computer (Beyda, Figures 1-2, column 3 lines 1-67, column 4 lines 9-23; Pollack Figures 1 and 4, column 3 lines 40-56, column 7 lines 36-50).

53. Regarding claim 20, Beyda and Pollack disclosed a method wherein the second computer is accessible via the world-wide web (Beyda, column 4 lines 1-8; Pollack, column 5 lines 56-67).

54. Regarding claims 21-29, the limitations of claims 21-29 are similar to the limitations of claims 1 and 4-9, and thus these claims are rejected using the same rationale.

55. Since all the limitations of the claimed invention were disclosed by the combination of Beyda and Pollack, claims 1-29 are rejected.

### ***Conclusion***

56. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

57. Refer to the enclosed PTO-892 for details and listings of pertinent prior art of record.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Jack Harvey  
SPE  
Art Unit 2142  
703-305-9705

tp  
April 13, 2004

  
JASON CARDONG  
PRIMARY EXAMINER  
Art. 2142